

Application No. 09/916,053
Amendment Dated March 5, 2004
Reply to Office Action of October 28, 2003

REMARKS

In the most recent Office Action, the Examiner rejected claims 1, 3 - 6, 8 - 28, 30 - 33 and 35 - 50 "under U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." This rejection is essentially a "new matter" rejection and is based upon the Examiner's position that the corrected identification of prior art, which was set forth in the amendment mailed to the United States Patent and Trademark Office on January 10, 2003, in a paragraph that replaced the originally filed paragraph beginning on line 7 of page 3 of the specification, constituted new matter.

Although Applicant respectfully disagrees with this position, for reasons which will be set forth in detail hereinafter, by this amendment Applicant has cancelled from the application the amended paragraph being objected to by the Examiner, and has presented the prior art information in a new Supplemental Information Disclosure Statement accompanying this amendment.

Applicant submits that the cancellation of the paragraph describing prior art does not constitute new matter since it does not in any way alter the description or breadth of the invention being claimed.

As was noted in Ex Parte Clark A. Anderson, et al., Appeal No. 95-2910, a copy of which was presented in Applicant's "Amendment Accompanying Request for Continued Examination (RCE)," the Board clearly stated that the purpose of the written description requirement "is to ensure that the applicants convey with reasonable clarity to those skilled in the art that they were in

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possession of the invention as of the filing date of the application.” Clearly the written description set forth in this application, even after cancelling the paragraph directed solely to prior art, does not alter Applicant’s disclosure of the invention in the original application. It is abundantly clear that the written description of the original application includes a disclosure that conveys with reasonable clarity to those skilled in the art that the Applicants were in possession of the invention being claimed herein, as of the filing date of the application.

As noted in previously presented arguments, the Federal Circuit has made it clear that for the purposes of the written description requirement, the invention is “whatever is now claimed.” Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The claimed invention clearly is supported by the original disclosure, even without considering any disclosure of prior art.

It is clear that the claims presently pending in this application set forth the invention that clearly was described in the application as originally filed. This fact was clearly pointed out in the “Amendment Accompanying Request for Continued Examination (RCE),” on page 11 thereof and for purposes of brevity will not be repeated herein.

Based on a review of the Office Action and discussions with Examiner Zirker, it was made clear that none of the previous prior art rejections were sustainable on the basis of the newly described and corrected statement regarding prior art. Therefore, the only rejection relevant to this application is the new matter rejection.

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As point out above, this new matter rejection is not sustainable, even if the corrected paragraph were left in the application. However, this corrected paragraph has been cancelled from the application, which further avoids any new matter issue.

It should be noted that in Anderson, supra, the Applicant actually amended the written specification to change the term “less than” to “greater than,” arguing that this was an inadvertent error, and that people skilled in the art clearly would understand from the originally presented claims that the intent was to describe the particular period of time as being “greater than” rather than as “less than.” In other words, the Board felt that the originally claimed invention included limitations pointing out that the reference to “less than” in the written description was incorrect. Confronted with this set of facts, the Board felt that the correction of the specification was appropriate and did not constitute new matter.

Applicant is not confronted with a similar fact situation in this case. However, Anderson does clearly set forth the proper legal standard for determining whether new matter has been introduced into the application. Moreover, Anderson makes it clear that the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. Applicant submits that the Examiner clearly has not met this burden, because no such evidence exists. The disclosure in this application, even including the corrected description of prior art, which has been cancelled, still constitutes a description of the invention defined by the claims. In other words, the description of the invention did not change by the amendment correcting the disclosure of the prior art. This fact should be

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abundantly clear as a result of the action being taken by the Applicant herein; namely, the cancellation of the paragraph objected to by the Examiner. This cancellation does not in any way alter the description of the invention since the cancelled paragraph relates solely to prior art; not to the invention.

In view of the amendment presented herein, Applicant submits that this application is now in condition for allowance and an indication to that effect is respectfully requested.

Respectfully submitted,

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